

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

8

Application Number

10/054,257

Filing Date

January 22, 2002

First Named Inventor

Frederick R. Bean et al.

Art Unit

3724

Examiner Name

P. Nguyen

Attorney Docket Number

TN-2239

## ENCLOSURES (check all that apply)

☒ Fee Transmittal Form☐ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/  
Incomplete Application☐ Reply to Missing Parts  
under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication to TC☒ Appeal Communication to Board  
of Appeals and Interferences☐ Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)  
(please identify below):

Return Post Card

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm

Black &amp; Decker Inc.

Signature

Printed Name

Adan Ayala, Esq.

Date

April 7, 2008

Reg.  
No.

38,373

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature

Typed or printed name

Adan Ayala, Esq.

Date

April 7, 2008

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.

Paid pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# **FREE TRANSMITTAL for FY 2008**

☐ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$) 510

## **Complete if Known**

Application Number	10/054,257
Filing Date	January 22, 2002
First Named Inventor	Frederick R. Bean et al.
Examiner Name	P Nguyen
Art Unit	3724
Attorney Docket No.	TN-2239

## **METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 02-2548 Deposit Account Name: Black & Decker (U.S.) Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

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## **FEE CALCULATION**

### **1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	310	155	510	255	210	105	_____
Design	210	105	100	50	130	65	_____
Plant	210	105	310	155	160	80	_____
Reissue	310	155	510	255	620	310	_____
Provisional	210	105	0	0	0	0	_____

### **2. EXCESS CLAIM FEES**

#### **Fee Description**

	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee(\$)</b>
_____ -20 or HP= _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee(\$)</b>
_____ - 3 or HP= _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

### **3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
_____ - 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

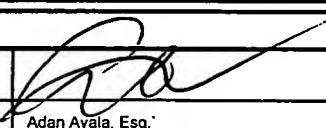
### **4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge) : Reply Brief

510

## **SUBMITTED BY**

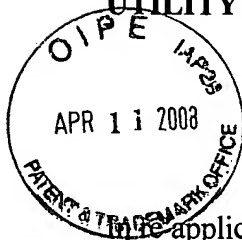
Signature		Registration No. (Attorney/Agent)	38,373	Telephone	410-716-2368
Name (Print/Type)	Adan Ayala, Esq.	Date	April 7, 2008		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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UTILITY PATENT

B&D No. TN2239



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: **Frederick R. BEAN et al.**

Serial No.: **10/054,257**

Examiner: **P. Nguyen**

Filed: **January 22, 2002**

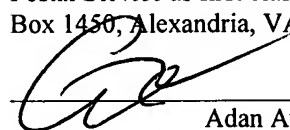
Group Art Unit: **3724**

For: **MITER SAW**

Assistant Commissioner for Patents  
Washington, DC 20231

**REPLY BRIEF**

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 4-7-08

  
\_\_\_\_\_  
Adan Ayala

Dear Sir:

This is in response to the Examiner's Answer mailed on February 7, 2008.

The rejection of Claim 13 under 35 USC § 103 based on the Chen/Meredith combination should be reversed for several reasons. First, the Examiner has not properly proven the facts he is alleging. Second, the rejection should be reversed because Meredith teaches away from the modification proposed by the Examiner. Third, if the Chen miter saw were modified as proposed by the Examiner, it would be rendered inoperable. Fourth, even if Chen were modified as shown in a sketch provided by the Examiner, the resulting device would not have all the claimed elements.

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**A. The Examiner Has Failed to Prove the Existence of the Facts He Relies Upon.**

Even though the Examiner has admitted that “Chen does not teach a first tab” (Ex. Answer, p. 3, ln. 10) and that “Meredith teaches the use of a tab but not the contact between the screw and the lower blade guard” (Ex. Answer, p. 4, lns. 2-3), the Examiner notes that the Chen/Meredith combination would result in the claimed arrangement where “the lower blade guard contacts the screw upon rotation of the lower blade guard... after the screw has been moved the second distance,” as called for in Claim 13, because of Chen’s teaching of a “small tolerance between the plate and the lower guard.”<sup>1</sup> Ex. Answer, p. 4, lns. 14-15.

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). A rejection based on facts beyond the record that do not meet such criteria is improper and should be reversed. *See In re*

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<sup>1</sup> The Examiner’s position would seem to contradict his original position from the final Office Action where he stated that “[i]t is well know (sic) the art that the plate and the lower guard have a small tolerance.” Now that he has been asked to provide proof of such teaching, he has relied on Chen, which reliance Applicants/Appellant fully question in the body of this Reply. But the Examiner seems to be unsure as to whether Chen does teach the “small tolerance,” as elsewhere in the Answer, the Examiner states that it is Meredith that “teaches the existence of the ‘small tolerance’ existing between the plate and the lower guard.” Ex. Answer, p. 7, lns. 3-5. Applicants/Appellant request that the Examiner clarify the record and point at where such teaching exists in the references.

To further support his finding that a small tolerance exists, the Examiner relies on unsubstantiated information that is not well known in the art or even on the record. In particular, the Examiner notes that “[i]n reality, the tolerance is between 1/16-2/16 of an inch.” Ex. Answer, p. 4, lns. 17-18. The Examiner has neither provided any documentary evidence of such tolerance as found in real-life applications, nor relied upon an official notice that can be properly traversed. Because such statement is not supported by any evidence, such statement should be stricken from the record.

*Zurko*, 258 F.3d 1379 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). In the present case, the Examiner has failed to make such unquestionable demonstration.

Rather than show where Chen (or any other prior art reference) describes such gap or tolerance, the Examiner provides a sketch, i.e., the second sketch in p. 5 of the Examiner's Answer ("the Second Sketch"), which he implies shows the Chen arrangement.

Applicants/Appellant believe this is misleading as the Second Sketch is not from Chen, but from Meredith. In particular, the Second Sketch is Meredith's FIG. 13a, which is a cross-sectional view of Meredith's FIG. 11. As shown in FIG. 11 of Meredith, the lower blade guard 20 will never overlap plate 66 near screw 69. Therefore the Second Sketch cannot teach a small tolerance between the lower blade guard 20 and the plate 66, as argued by the Examiner. If anything, the Second Sketch shows a great distance between lower blade guard 20 and screw 69, contradicting the Examiner's arguments.

Because the Examiner relies on facts that he cannot prove, as required by law, the present obviousness rejection is improper and should be reversed.

**B. Meredith Teaches Away from the Modification Proposed by the Examiner.**

Even assuming for the sake of argument that a small gap exists between the lower blade guard and the plate, Meredith teaches away from providing a tab in such area as proposed by the Examiner. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

As admitted by the Examiner, Meredith does not teach "the contact between the screw and the lower blade guard." Ex. Answer, p. 4, lns. 2-3. Indeed, FIGS. 1 and 11 of Meredith show that

lower blade guard 42 does not cover plate 66, so that the lower blade guard 42 is free to move regardless of the location of the screw 69. Meredith accordingly teaches that a tab and the screw should be kept distant from, rather than close to, the lower blade guard so as to prevent interference.

Because Meredith teaches away from the proposed modification, it is improper to combine Chen and Meredith. Therefore the obviousness rejection should be reversed.

**C. Modifying Chen to Add the Meredith Tab Would Render the Chen Miter Saw Inoperable.**

If the Meredith tab were added to the Chen miter saw as proposed by the Examiner, the modification would render the Chen miter saw inoperable for its intended purpose.

If a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the present case, providing a tab in between the plate and the lower blade guard, where a small gap exists according to the Examiner, would jam the lower blade guard and not permit its movement. This in turn would not allow the saw assembly to rotate downwardly to perform a cutting operation.

In other words, such jam would stop a user from being able to use the Chen miter saw from cutting a workpiece., i.e., its intended purpose. Because the Examiner's modification would render the miter saw inoperable for its intended purpose, the proposed modification is improper. Therefore, the obviousness rejection should be reversed.

**D. The Third Sketch Does Not Have All the Claimed Elements.**

In the Examiner's Answer, the Examiner provided a third sketch (hereinafter "the Third Sketch") showing "the plate in Chen's saw assembly being provided with a first tab." Ex. Answer, p. 6, lns. 2-3. This is misleading.

The Third Sketch is a modified version of FIG. 13b of Meredith, which in turn is a cross-sectional view of the rear of the upper blade guard, looking downwardly. Considering that the Examiner admitted that "Meredith teaches the use of a tab but not the contact between the screw and the lower blade guard." (Ex. Answer, p. 4, lns. 2-3), it is difficult to see how the now-extended lower blade guard would contact screw 69 since it would still bypass such screw if the construction of the Third Sketch is maintained.

In fact, it is difficult to see how the lower blade guard would ever contact the screw in the Third Sketch. That is because the lower blade guard shown in the Third Sketch cannot move downwardly towards screw 69 as it is contacting upper blade guard 40. The lower blade guard can thus only move in and out of the page, bypassing screw 69 altogether.

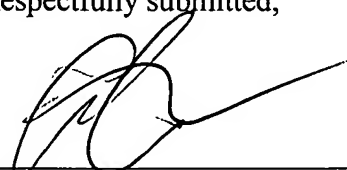
By contradistinction, Claim 13 requires that the "lower blade guard contact[] the screw upon rotation of the lower blade guard." Being that such result cannot be accomplished with the arrangement shown in the Third Sketch, the Chen/Meredith combination cannot render unpatentable Claim 13. Therefore, the rejection based on Chen/Meredith should be reversed.

**UTILITY PATENT**

**B&D No. TN2239**

Based on the foregoing, Applicant/Appellant urges the Board to rule that Claim 13 is patentable over the Chen/Meredith combination.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Adan Ayala', written over a horizontal line.

Adan Ayala  
PTO Reg. No. 38,373  
Attorney for Applicants/Appellant